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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,571	02/11/2004	David M. Hilbert	FXPL-01082US0	6011
23910 7590 11/25/2009 FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108				
EXAMINER				
LIU, LIN				
ART UNIT		PAPER NUMBER		
2445				
NOTIFICATION DATE		DELIVERY MODE		
11/25/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OFFICEACTIONS@FDML.COM

### Office Action Summary

**Application No.**

10/777,571

**Applicant(s)**

HILBERT ET AL.

**Examiner**

LIN LIU

**Art Unit**

2445

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-7, 9-12, 14 and 16-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-12, 14, 16-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is responsive to communications filed on 06/22/2009

Claims 1-3, 5-7,9-12,14 and 16-33 are pending and have been examined.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims **1-3, 12 and 14, 16-23, 25-28 and 31-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hanna et al. (Patent no.: US 7,054,905 B1)** in view of **Arnold (Patent no. US 6,275,848 B1)** and **Kobata et al. (PGPUB: US 2003/0023695 A1)**.

With respect to **claim 19**, Hanna teaches a system for processing electronic mail messages, the system comprising: a message parser configured to (Hanna: fig. 2):

accept an electronic mail message, the electronic mail message including a file attachment (Hanna: fig. 2, col. 4, lines 18-24, noted that email server 108 accepts email message including attachment.);

in response to a positive determination, store the file attachment in an attachment location (Hanna: col. 4, lines 29-37, noted that the attachment is stored in file server 111); and

insert an attachment reference associated with the attachment location wherein the attachment reference causes submission of validation information to an attachment server storing the attachment location (Hanna: col. 5, lines 26-31 and lines 57-67, noted that URL address of the attachment is sent to the recipient with the modified message.);

embed a security token into the electronic mail message, wherein the security token specifies a security credential that would be transmitted to the attachment server when said attachment reference is utilized (Hanna: col. 5, lines 8-16 and lines 57-67, noted the authentication mechanisms); and

a attachment reference module that manages the generation of the attachment reference (Hanna: col. 5, lines 26-31, insertion of URL reference to the attachment file); and

the attachment server that stores the file attachment in the attachment location, wherein the attachment server receives a retrieval request from a recipient (Hanna: col. 5, lines 1-16), **performs transduction on the file attachment prior to providing the file attachment to the recipient** (Hanna: col. 4, lines 41-50 & col. 6, lines 6-11, noted the encryption of the file).

However, Hanna does not explicitly teach a method of determining whether to remove the file attachment; and a method of **performing transduction on a file attachment includes reducing the size of the attachment or streaming the attachment to said recipient; and wherein reducing the size of the attachment includes one or more of: compressing the file attachment, generating a lower bandwidth version of the file attachment, and reducing the size or resolution of an image in the file attachment.**

In the same field of endeavor, Arnold teaches a method of determining whether to remove the file attachment (Arnold: fig. 2 steps 206-208, and col. 4, lines 6-24, noted that detachment rule is applied).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of applying a detachment rules of an attachment file as taught by Arnold in Hanna's invention in order to apply the filter criteria in detaching the file attachment from the email message before sending the message to the recipients. The advantage of such method is that it avoids having SMTP in handling multiple large attachments and preventing recipient's email applicant from crashing (Arnold: col. 1, lines 39-61).

However, the combined method of Hanna-Arnold fails to teach **a method of performing transduction on a file attachment includes reducing the size of the attachment or streaming the attachment to said recipient; and wherein reducing the size of the attachment includes one or more of: compressing the file**

**attachment, generating a lower bandwidth version of the file attachment, and reducing the size or resolution of an image in the file attachment.**

In the same field of endeavor, Kobata teaches **a method of performing transduction on a file attachment includes reducing the size of the attachment** (Kobata: page 5, paragraph 81 and page 9, paragraphs 126-127, noted the compression and encryption of the file) **or streaming the attachment to said recipient** (Kobata: page 5, paragraphs 74-76); **and wherein reducing the size of the attachment includes one or more of: compressing the file attachment** (Kobata: page 5, paragraph 81 and page 9, paragraphs 126-127), **generating a lower bandwidth version of the file attachment, and reducing the size or resolution of an image in the file attachment.**

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute the method of compressing and encrypting a file at the file server as taught by the Kobata with the encryption method of Hanna's invention in order to achieve bandwidth efficient in delivering a file from the server to the recipient side (Kobata: page 8, paragraph 123).

With respect to **claim 20**, Hanna teaches the system of claim 19 wherein the attachment reference is a hyperlink (Hanna: col. 5, lines 26-31, URL reference).

With respect to **claim 21**, Hanna teaches all the claimed limitations, except that she does not explicitly teach a method of determining a size of the file attachment.

In the same field of endeavor, Arnold teaches determining a size of the file attachment (Arnold: col. 4, lines 58-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of applying a detachment a size of the file attachment as taught by Arnold in Hanna's invention in order to determine whether, or how long, the attachment shall remain on the server (Arnold: col. 4, lines 58-67).

With respect to **claim 22**, Hanna teaches the system of claim 19, wherein determining whether to remove the file attachment comprises determining an identity of a recipient of the electronic mail message (Hanna: fig. 2, col. 4 lines 17-37, it is an inherent feature to identify the recipient's email address.).

With respect to **claim 23**, Hanna teaches a method of determining a type of the file attachment (Hanna: col. 4, lines 25-28).

With respect to **claim 25**, Hanna teaches the system of claim 24, wherein the executable configured to prompts a recipient for validation information and then submits the received validation information to the server storing the attachment location (Hanna: col. 5, lines 8-16 & lines 57-67).

With respect to **claim 26**, Hanna teaches the system of claim 19, wherein the attachment is a media file (Hanna: col. 4, lines 25-28, noted the graphical image) and the system streams the file attachment to a recipient (Hanna: col. 4, lines 37-40).

With respect to **claim 27**, Hanna teaches the file system of claim 19, wherein the attachment is a document including text and the system translates the text (Hanna: col. 4, lines 25-28, document file).

With respect to **claim 28**, Hanna teaches the system of claim 19, wherein the server storing the file attachment prompts a recipient for validation information when the recipient attempts to retrieve the file attachment (Hanna: col. 5, lines 8-16 & lines 57-67).

In regard to **claims 1-3, 12 and 14, 16-18**, the limitations of these claims are substantially the same as those in claims 19-23, and 25-28. Therefore the same rationale for rejecting claims 19-23, and 25-28 is used to reject claims 1-3, 12 and 14, 16-18. By this rationale **claims 1-3, 12 and 14, 16-18** are rejected.

With respect to **claim 31**, Hanna teaches all of the claimed limitations except that he does not explicitly teach a method of inspecting the file attachment and wherein if the file attachment contains a media file, the attachment server streams said media file to the recipient, else if the file attachment contains an image, the attachment server reduces the resolution of said image.

In the same field of endeavor, Kobata teaches a method of streaming data from the file server to the recipients (Kobata: page 5, paragraphs 73-76).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of data streaming from the file server to the recipients as taught by Kobata in Hanna's invention in order to reduce the amount of time for full delivery of the file (Kobata: page 5, paragraph 75).

With respect to **claims 32 & 33**, Hanna teaches the all of the claimed limitations except that he does not explicitly teach a method of wherein the attachment server reads a configuration file containing a set of categories in order to determine whether to



perform transduction on the file attachment before providing said attachment to the recipient and wherein two or more of the categories in the configuration file are cross-linked, such that the transduction is performed by the attachment server according to both a predetermined size of the file attachment and according to the recipient of the electronic mail message.

In the same field of endeavor, Kobata teaches a method of wherein the attachment server reads a configuration file containing a set of categories in order to determine whether to perform transduction on the file attachment before providing said attachment to the recipient and wherein two or more of the categories in the configuration file are cross-linked, such that the transduction is performed by the attachment server according to both a predetermined size of the file attachment and according to the recipient of the electronic mail message (Kobata: page 9, paragraphs 128-130, noted the firewall/proxy server file size limits on the network).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method above as taught Kobata in Hanna's invention in order to prevent an overload of network by transmitting large files and informing users to adjust accordingly (Kobata: page 9, paragraphs 129-130).

5. Claims 5-7 and 9-11, 24 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hanna et al. (Patent no.: US 7,054,905 B1)** in view of **Arnold (Patent no. US 6,275,848 B1)**, **Le Pennec et al. (PGPUB: US 2005/0076082 A1)** and further in view of **Kobata et al. (PGPUB: US 2003/0023695 A1)**.

With respect to **claim 5**, Hanna teaches a method for processing electronic mail messages, the method comprising:

accepting an electronic mail message, the electronic mail message including a file attachment (Hanna: fig. 2, col. 4, lines 18-24, noted that email server 108 accepts email message including attachment.);

in response to a positive determination, storing the file attachment in an attachment location (Hanna: col. 4, lines 29-37, noted that the attachment is stored in file server 111); and

inserting in the message, an attachment reference that automatically submits validation information to a server storing the file attachment and retrieves the file attachment from the attachment location on an attachment server (Hanna: col. 5, lines 26-31 and lines 57-67, noted that URL address of the attachment is sent to the recipient with the modified message.);

embedding a security token into the electronic mail message, wherein the security token specifies a security credential that would be transmitted to the attachment server when said executable file is utilized (Hanna: col. 5, lines 8-16 and lines 57-67, noted the authentication mechanisms); and

**performing transduction on the file attachment by the attachment server prior to providing the file attachment to the recipient** (Hanna: col. 4, lines 41-50 & col. 6, lines 6-11, noted the encryption of the file).

However, Hanna does not explicitly teach a method of determining whether to remove the file attachment; a method of inserting an executable file reference

associated with the attachment location; and a method **of performing transduction on a file attachment includes reducing the size of the attachment or streaming the attachment to said recipient; and wherein reducing the size of the attachment includes one or more of: compressing the file attachment, generating a lower bandwidth version of the file attachment, and reducing the size or resolution of an image in the file attachment.**

In the same field of endeavor, Arnold teaches a method of determining whether to remove the file attachment (Arnold: fig. 2 steps 206-208, and col. 4, lines 6-24, noted that detachment rule is applied).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of applying a detachment rules of an attachment file as taught by Arnold in Hanna's invention in order to apply the filter criteria in detaching the file attachment from the email message before sending the message to the recipients. The advantage of such method is that it avoids having SMTP in handling multiple large attachments and preventing recipient's email applicant from crashing (Arnold: col. 1, lines 39-61).

In the same field of endeavor, Le Pennec teaches a method of inserting an executable file reference associated with the attachment location (Le Pennec: page 2, paragraphs 27 & 32, and page 3, paragraphs 34 & 37, noted the executable file is attached to the original email message to automatically retrieving the original file attachment).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute the method of attaching an executable data file as taught by Le Pennec in the combined method of Hanna-Arnold's invention in order to download the original attachment files from the server. The advantage to integrate such method is that it bypasses the file attachment size limitation, and avoids sending large files and overloading the user's mailbox (Le Pennec page 1, paragraphs 10-11).

However, the combined method of Hanna-Arnold-Le Pennec fails to teach a **method of performing transduction on a file attachment includes reducing the size of the attachment or streaming the attachment to said recipient; and wherein reducing the size of the attachment includes one or more of: compressing the file attachment, generating a lower bandwidth version of the file attachment, and reducing the size or resolution of an image in the file attachment.**

In the same field of endeavor, Kobata teaches a **method of performing transduction on a file attachment includes reducing the size of the attachment** (Kobata: page 5, paragraph 81 and page 9, paragraphs 126-127, noted the compression and encryption of the file) **or streaming the attachment to said recipient** (Kobata: page 5, paragraphs 74-76); **and wherein reducing the size of the attachment includes one or more of: compressing the file attachment** (Kobata: page 5, paragraph 81 and page 9, paragraphs 126-127), **generating a lower bandwidth version of the file attachment, and reducing the size or resolution of an image in the file attachment.**

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute the method of compressing and encrypting a file at the file server as taught by the Kobata with the encryption method of Hanna's invention in order to achieve bandwidth efficient in delivering a file from the server to the recipient side (Kobata: page 8, paragraph 123).

With respect to **claims 6 and 7**, Hanna teaches all of the claimed limitations except that he does not explicitly teach a method of prompting validation information which enables the retrieval of the file attachment from the attachment location.

In the same field of endeavor, Le Pennec teaches a method of prompting validation information which enables the retrieval of the file attachment from the attachment location (Le Pennec: page 2, paragraphs 27 & 32, and page 3, paragraphs 34 & 37). Same motivation used in claim 5 applies equally as well to claims 6 and 7.

With respect to **claim 10**, Hanna teaches the method of claim 5, wherein determining whether to remove the file attachment comprises determining an identity of a recipient of the electronic mail message (Hanna: fig. 2, col. 4 lines 17-37).

With respect to **claim 11**, Hanna teaches the method of claim 5, wherein determining whether to remove the file attachment comprises determining a domain of a recipient email address (Hanna: fig. 2, col. 4 lines 17-37).

With respect to **claims 29 and 30**, the combined method of Hanna-Arnold-Kobata teaches attaching a URL reference to the email message (Hanna: col. 5, lines 26-31, URL reference). However, Hanna-Arnold-Kobata does not explicitly teach a method of attaching a data file as attachment reference, and wherein the data file is

configured to enable an application stored on a recipient computer to retrieve the attachment from the server storing the attachment.

In the same field of endeavor, Le Pennec teaches a method of attaching a data file as attachment reference, and wherein the data file is configured to enable an application stored on a recipient computer to retrieve the attachment from the server storing the attachment (Le Pennec: page 2, paragraph 27, noted the executable file is attached to the original email message).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute the method of attaching an executable data file as taught by Le Pennec in the combined method of Hanna-Arnold- Kobata's invention in order to download the original attachment files from the server. The advantage to integrate such method is that it bypasses the file attachment size limitation, and avoids sending large files and overloading the user's mailbox (Le Pennec page 1, paragraphs 10-11).

In regard to **claim 24**, the limitation of this claim is substantially the same as those in claims 29-30. Therefore the same rationale for rejecting claims 29-30 is used to reject claim 24. By this rationale **claim 24 is rejected**.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Hanna et al. (Patent no.: US 7,054,905 B1)** in view of **Arnold (Patent no. US 6,275,848 B1)**, **Le Pennec et al. (PGPUB: US 2005/0076082 A1)** and further in view of **Kobata et al.**

**(PGPUB: US 2003/0023695 A1)** and further in view of **Tsai Patent no.: US 6,839,741 B1**.

With respect to **claim 9**, the combined method of Hanna-Arnold-Le Pennec-Kobata teaches all of the claimed limitations except that he does not explicitly teach a method of converting the file to a commonly usable format.

In the same field of endeavor, Tsai teaches a method of converting the file to a commonly usable format (Tsai: col. 4, line 61 to col. 5 line 8, and col. 6, lines 30-57, noted that the server converts the attachment file into a format that is viewable and downloadable by a recipient.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method above as taught by Tsai in the combined method of Hanna-Arnold- Le Pennec-Kobata's invention in order offload the processing work of the attachment file to the file server and reduce the workload on the recipient.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-3, 5-7, 9-12,14 and 16-33 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIN LIU whose telephone number is (571)270-1447. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Srivastava Vivek can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should



Art Unit: 2445

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/Lin Liu/

Examiner, Art Unit 2445

/NIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2445